

IN THE U.S. PATENT AND TRADEMARK OFFICE

Appl. No. : 09/559,499
Applicant : Piikivi et al.
Filed : April 27, 2000
TC/AU : 3625
Examiner : Yogesh C. Garg

Docket No. : 872.0017.USU
Customer No. : 29683

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#19 Reply
Brief
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APPELLANT'S REPLY BRIEF

Sir:

Commensurate with the EXAMINER'S ANSWER dated December 2, 2003, Applicant/Appellant hereby submits this REPLY BRIEF to the Board of Patent Appeals and Interferences (hereinafter, the Board) under 37 C.F.R. 1.193(b)(1) and M.P.E.P. § 1208 in triplicate. Applicant believes that no fee is due with this paper. However, should the undersigned attorney be mistaken, please debit Deposit Account No. 50-1924 as appropriate for any fee that may be due, and if necessary, consider this a petition for an extension of time under 37 C.F.R. § 1.136(b) that may be required to effect entry of this Reply Brief.

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REMARKS:

The Examiner's Answer at page 4, item (7), asserts that as to Issue A, claims 1-6, 21, 7, 10-15, 16-20, and 22-31 stand or fall together. Applicant does not concur, and has argued claims 11, 12, 18 and 21 separately under Issue A in the Appeal Brief in support of the separability of this grouping of claims.

Respecting Issue A: The Examiner has disagreed with Issue A as stated in the Appellant's Appeal Brief. Issue A and a clause from claim 1 are reproduced below from the Appeal Brief. The clause of claim 1 is submitted as representative of the relevant clause in each independent claim.

Issue A: Does any combination of references teach or suggest a computer automatically sending a message to a mobile station in response to receiving a particular message from a commerce-related site or server?

Relevant clause from claim 1: in response to automatically detecting the presence of the message, sending a message from the computer to a mobile station over a bi-directional transmission link;

Specifically, the Examiner's Answer asserts at page 12 that "Claim 1 and all other independent claims merely recite the limitation of sending a message to the mobile station after automatically detecting the presence of the message but **do not claim automatically sending the message to the mobile station.**" (emphasis in original). From the portion of the Appeal Brief concerning Issue A, clearly the Appellant's position is that the claim term "in response to" as recited above requires that the response (e.g., the sending of the

message) be automatic. The Examiner's Answer as quoted above indicates the Examiner's position is that the term "in response to" means merely "after".

Disposition of this appeal concerning Issue A appears to turn on whether the claim term "in response to" implies an automatic action. Appellant contends that a second action (e.g., sending a message from the computer to a mobile station) that is "in response to" a first action (e.g., detecting the presence of the message) both follows the first action in time and is caused by the first action. This is consistent with the plain meaning of the term "in response to"; the chronological relation between the first and second actions necessarily flows from their underlying cause and effect relation. Webster's New Universal Unabridged Dictionary (New World Dictionaries/Simon & Schuster, 1983) defines "response" as "1. something said or done in answer to something else; an answer; reply." The claim term mandates a causal relation between the first and second actions, rendering an additional adjective "automatic" repetitive and unnecessary. As arranged in claim 1, detecting the presence of the message and sending a message from the computer to a mobile station constitute a combined action, because the second action necessarily follows the first. In short, Appellant contends that the term "in response to" is properly characterized by "automatically after", and not merely "after" as contended in the Examiner's Answer.

Respecting Issue B: Applicant relies on the arguments made in the Appeal Brief, and no further comment is deemed necessary concerning Issue B.

Respecting Issue C: Issue C and a clause from claim 1 are reproduced below from the Appeal Brief.

Issue C: Can the Wang reference be modified to make obvious that a user authentication message or user personal identification is passed outside a mobile station as recited in claims 1, 10 and 28?

Relevant clause from claim 1: passing the user authentication message from the mobile station to the computer over the bi-directional transmission link;

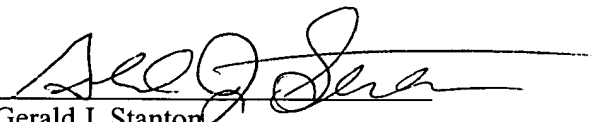
Appellant notes that the distinction in the Wang reference between transaction approval/authorization and user authentication/identification, as described in the Appeal Brief at pages 14-16, is not contended in the Examiner's Answer. One significant distinction between Wang and the claims of Issue C lay in the difference between *user* and *transaction*. As characterized in the Appeal Brief at pages 14 and 15, Wang's principle of operation includes: [1] a transaction is approved, if at all, only within the PEAD; [2] a transaction approval is transmitted from the PEAD; and [3] user identification is never transmitted from the PEAD. Any modification to Wang under 35 U.S.C. § 103 cannot undermine its principle of operation or render it unsatisfactory for its intended purpose. M.P.E.P. § 2145, part X, para. D.

Claims 1 and 10 recite that a *user* authentication message is passed from the mobile station, and claim 28 (when read in context of claim 23 from which it depends) mandates (in the only contended alternative within claim 28) that *user* identification is passed from the mobile station. Appellant asserts that Wang cannot be modified so that user-specific data is passed from the PEAD. To do so would categorically violate [3] above, and undermine [1] and [2] as follows. To modify Wang so that user-specific data is sent from the PEAD necessarily implies that the electronic system apart from the PEAD approves or

disapproves the transaction, because obtaining transaction approval is the entire purpose of transferring user-related data. That result is contrary to principles [1] and [2] above, and explicitly rejected for the PEAD at Wang, col. 6, lines 25-28. Anything apart from the PEAD internally approving a transaction is contrary to the whole teaching of Wang, and Applicant contends strongly that Wang cannot be so modified. Even apart from undermining its principle of operation and rendering it unsatisfactory for its intended purpose (transaction approvals internal to the PEAD), such a modification fails to consider disclosure in Wang that explicitly teaches away from that modification. M.P.E.P. § 2141.02 (as a whole inquiry of prior art includes disclosure that teaches away) and § 2145.

For at least the above reasons, the Applicant/Appellant respectfully requests the Board of Patent Appeals to reverse the final rejection of claims 1, 3-7, 9-16 and 18-31, and rule that the pending claims are patentable over the references that were cited and relied upon by the Examiner.

Respectfully submitted:
HARRINGTON & SMITH, LLP



Gerald J. Stanton
Reg. No.: 46,008

February 2, 2004
Date

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

February 2, 2004
Date


Ann Okrentowich